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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,113	11/01/2005	Shinji Nakade	Q85522	9389
65565 7590 08/17/2010 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213				
EXAMINER				
RICCI, CRAIG D				
ART UNIT		PAPER NUMBER		
1628				
NOTIFICATION DATE		DELIVERY MODE		
08/17/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SUGHRUE265550@SUGHRUE.COM  
USPTO@SUGHRUE.COM  
PPROCESSING@SUGHRUE.COM

### Office Action Summary

**Application No.**

10/519,113

**Applicant(s)**

NAKADE ET AL.

**Examiner**

CRAIG RICCI

**Art Unit**

1628

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 10, 20, 22, 24, 25, 27, 29, 30, 44, 46, 47, 49, 51, 52, 61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 61 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 20 is/are rejected.
- 7) ☒ Claim(s) 22, 24, 25, 27, 29, 30, 44, 46, 47, 49, 51 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/09/2010 has been entered.

### *Status of the Claims*

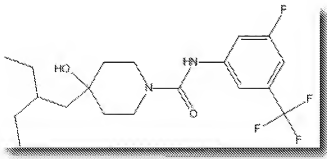
2. The amendments filed 7/09/2010 were entered.

### *Response to Arguments*

3. Applicants' arguments, filed 7/09/2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

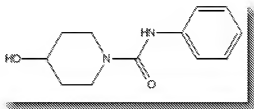
### *Election/Restrictions*

4. In the Action mailed on 9/01/2009, Applicant's election **without** traverse of the following compound species was acknowledged:



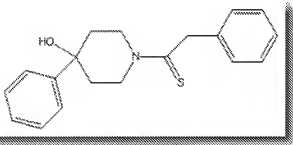
5. The elected species reads on current claims 10, 20, 22, 24-25, 27, 29, 30, 44, 46-47, 49 and 51-52.

6. In a previous Action it was noted that the elected species was searched and was deemed free of the prior art. Accordingly, the search was expanded as called for under current Office Markush practice - a compound by compound search - to include a single additional species.



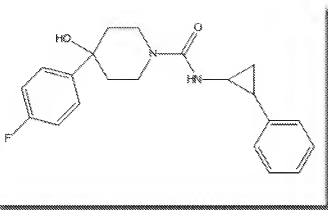
That species was . Applicant overcame the rejection based on said species by amending the claims.

7. Accordingly, the search was again expanded as called for under current Office Markush practice - a compound by compound search - to include a single additional species. That species



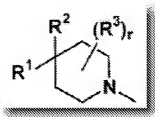
was . Applicant again overcame the rejection based on said species by amending the claims.

8. Accordingly, the search has again been expanded as called for under current Office Markush practice - a compound by compound search - to include a single additional species.



That species is

wherein (in formula (I))



A is wherein **R<sup>1</sup>** is a substituent (i.e., carbocyclic ring optionally with substituent(s) (see Specification Page 16 for a definition of “substituent” of ring A)), **R<sup>2</sup>** is hydroxyl; **R<sup>3</sup>** is a substituent wherein **r** represents 0; **X** is a single bond; **Y** is -CO-; **Z** is -NH-; and **B** is a cyclic group optionally with substituent(s). The above species reads on instant claims 10 and 20. A rejection as to those claims follows.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

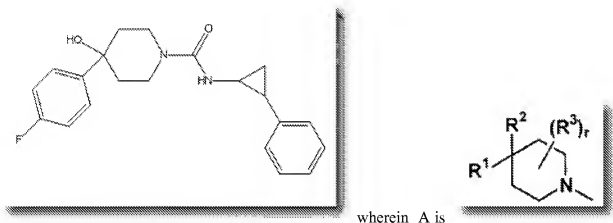
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claim 10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Arya et al (Indian J Chemistry, Section B: Organic Chemistry Including Medicinal Chemistry**

**15B(7):635-640, 1977) as evidenced by the attached STN Search Report (ACCESSION NUMBER 1978:74324).**

11. Claim 1, as amended, is drawn to a compound represented by formula (I) which encompasses the following compound species



wherein A is

wherein  $R^1$  is a substituent (i.e., carbocyclic ring optionally with substituent(s) (see Specification Page 16 for a definition of “substituent” of ring A)),  $R^2$  is hydroxyl;  $R^3$  is a substituent wherein  $r$  represents 0;  $X$  is a single bond;  $Y$  is  $-CO-$ ;  $Z$  is  $-NH-$ ; and  $B$  is a cyclic group optionally with substituent(s). The above species reads on claims 10 and 20.

12. As evidenced by the attached STN Search Report (ACCESSION NUMBER 1978:74324), *Arya et al* teach the above compound species (CAS RN 65535-75-3). Accordingly, instant claims 10 and 20 are anticipated.

#### ***Claim Objections***

13. Claims 22, 24-25, 27, 29, 30, 44, 46-47, 49 and 51-52 are objected to as depending from a rejected claim.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRAIG RICCI whose telephone number is (571) 270-5864. The examiner can normally be reached on Monday through Thursday, and every other Friday, 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Padmanabhan "Paddy" Sreenivasan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CRAIG RICCI/  
Examiner, Art Unit 1628

/Brandon J Fetterolf/  
Primary Examiner, Art Unit 1642